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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,034

04/13/2006

Dominique Marianne Lucienne Flahaut

FLAHAUT

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HENRY M FEIEREISEN, LLC

HENRY M FEIEREISEN

708 THIRD AVENUE

SUITE 1501

NEW YORK, NY 10017

EXAMINER

YANG, JIE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/533,034	Applicant(s) FLAHAUT, DOMINIQUE MARIANNE LUCIENNE	
	Examiner JIE YANG	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-73 is/are pending in the application.
- 4a) Of the above claim(s) 48, 55, 59-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 42-47, 49-54 and 56-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 48, 55, and 59-73 are withdrawn from consideration as being directed to a non-elected group and claims 42-47, 49-54, and 56-58 remain for examination, wherein claims 56 and 57 are amended.

Status of the Precious Rejection

Previous objection of claims 56 and 57 under 35 U.S.C. 112, second paragraph have been withdrawn in view of the applicant's amendment filed in 03/31/2009.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42-47, 49-54, and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimoto et al (EP 0 391 381 A1, thereafter EP'381) in view of Poole et al (US 5,328,499, thereafter US'499) and Gennari et al (US 5,049,355, thereafter US'355).

EP'381 in view of US'499 and US'355 is applied to the claims 42-47, 49-54, and 56-58 for the same reason as stated in the previous rejection dated 10/1/2008.

Art Unit: 1793

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 42-44, 46-47, 49, 52-54, and 56-57 are provisionally rejected under 35 U.S.C.101 as claiming the same invention as that of claims of 1-3, 9-11, 18-19 copending application No. 10/533,850 (Hereinafter PG'850) for the same reason as stated in the previous rejection dated 10/1/2008. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. (The applicant notes 15-17 of PG'850 have been cancelled).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

Art Unit: 1793

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 45, 50-51, and 58 are rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 4-8, and 12-14, of copending patent application 10/533,850 (Hereinafter PG'850) .

Claims 4-8, and 12-14 is applied to the claims 45, 50-51, and 58 for the same reason as stated in the previous rejection dated 10/1/2008.

Response to Arguments

Applicant's arguments filed on 03/31/2009 with respect to claims 42-47, 49-54, and 56-58 have been fully considered but they are not persuasive.

Applicant's arguments are summarized as follows:

1, Regarding the rejections for independent claims 42, 43, and 58, EP'381 describes a heat-resistant alloy which is characterized by the absence of oxygen, there is no reason for a person skilled in the art to look at US'499 and find motivation to take the disclosure of, for example, "oxygen" for incorporation into the steel compositions in EP'381, when the US'499 relates to steel composition that is characterized by the presence of tantalum and the presence of yttrium which is absent in EP'381 and the present invention.

2, Assumed property of an alloy itself is secondary and cannot be used as basis to formulate a desired composition; and the mere fact that one steel composition contains a particular alloying element by itself means nothing because it develops its effect only in combination with other alloying elements. Thus an artisan in the field of metallurgy will not look at an alloying element in isolation and assume a particular effect in another steel composition as a result of using this alloying element.

3, the approach taken by the Examiner to pick and choose among individual portion of various prior art references as a mosaic to recreate a facsimile of the claimed invention is thereof ill-advised. The EP'381 and US'499 references were combined piecemeal without any suggestion or motivation for their combination and without regard to the purpose of applicant's invention. It is applicant's contention that the Examiner relied upon hindsight to arrive at the determination of obviousness.

4, Presence of hafnium as a metallic element as well as the presence of hafnium oxide is set forth. US'355 clearly lacks the presence of hafnium and fails to disclose the percentage of hafnium contained in the alloy composition.

Responses are as follows:

Regarding the argument 1, although EP'381 does not specify the range of 0.001 to 0.7wt%O, there is no evidence to conclude being absence of oxygen of the EP'381's alloy as asserted in the applicant's argument. The inevitable impurities as taught by EP'381 may include oxygen because EP'381 teaches that the alloy is manufactured by regular high-frequency melting and centrifugal casting (Example of EP'381) and EP'381

Art Unit: 1793

does not specify to exclude oxygen from the alloy. Applicant's argument that US'499 relates to steel composition that is characterized by the presence of tantalum and the presence of yttrium which is absent in EP'381 and the present invention also lacks merit, because both EP'381 and the instant claims recite to add tantalum in the alloy (refer to the instant claim 42 and the rejection for claim 42 in the previous office action marked 10/1/2008); EP'381 further teaches adding up to 0.5wt% Y in the alloy (Page 5, lines 16-19 of EP'381). The Examiner notes that the term of "comprising" in the instant claims 42, 43 and 58 does not exclude yttrium from the claimed alloy.

Regarding the argument 2, the Examiner disagrees with the applicant's argument. The applicant has concluded that an artisan in the field of metallurgy will not look at an alloying element in isolation and assume a particular effect in another steel composition as a result of using this alloying element without any supporting evidence. EP'381 in view of US'499 teaches an alloy with the composition ranges overlap the composition ranges of the alloy as recited in the instant claims, which is a prima facie case of obviousness. SEE MPEP 2144.05 I. Detail rejection can refer to the previous office action marked 10/1/2008.

Regarding the arguments 3 and 4, the applicant's arguments are against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, EP'381 in view of US'499 and US'355 teaches the limitations of instant claims 42-47, 49-54, and 56-58. As pointed out

Art Unit: 1793

in the previous office action marked 10/1/2008, EP'381 in view US'499 and US'355 teaches an aging treated heat-resistant alloy with the similar composition and desired oxide dispersion as recited in the instant invention. US'499 specifically teaches that the desired oxide dispersion may reduce ductility results (Col.1, lines 7-10, table 3, and Col.4, lines 51-69 of US'499) and US'355 teaches HfO_2 is well known as one of dispersion metal oxides in the oxide dispersion strengthened alloys, which may improve the ductility and strength of the alloy (Abstract of US'355). These are proper motivations for the combination of EP'381 with US'499 and US'355.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1793

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-270-1884.

The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY

/Roy King/
Supervisory Patent Examiner, Art Unit 1793